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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,092

03/19/2004

Howard E. Farran

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11/24/2008

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/805,092	<b>Applicant(s)</b> FARRAN, HOWARD E.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-40 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-40 and 42-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Citation of Prior Art***

1. Responsive to applicant's acknowledged "duty to disclose information, which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56", applicant furnished by way of an IDS highly relevant portions of the March 2003 issue of Dental Practice Report. Essentially this magazine takes discussions from the Internet Dental Forum (a competitor to applicant's Dental Town online forum) and publishes them in the magazine as a "Clinically Speaking" feature – consistent with the essence of applicant's invention. Because applicant provided the March 2003 issue and applicant's earliest date is 3/19/2003, the examiner chose at the time not to use this highly relevant reference in an art rejection. Upon further inspection, the March 2003 issue makes it clear that this Clinically Speaking feature was an ongoing monthly feature and further than applicant himself is a subscriber of Dental Practice Report. It is unclear why applicant did not submit or describe an earlier issue, but as Examiner certainly expected an earlier issue to also contain the relevant Clinically Speaking feature, he felt compelled to spend his and several librarians' time locating such an earlier issue. As can be seen by the enclosed PTO-892, the Jan/Feb 2003 issue indeed contains this Clinically Speaking feature and it has been cited and has been applied in a new art rejection below. Also cited are different examples (more than 1 year prior to applicant's invention) of postings in applicant's own Dental Town internet interactive forum which describe the concept of making postings on the forum and then publishing the posted

forum content in applicant's own Dental Town magazine, as well as other features of applicant's Dental Town forum which are found in the claims.

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- "The Challengers" is a thread/post in applicant's Dental Town forum that describes how users were asked to post reviews of dentistry software products and that the information was then published in the December, 2000 issue of applicant's DentalTown magazine.
- "January Dental Town Article" is a thread/post in applicant's Dental Town forum that describes how users can post case presentations online and then they can be published in applicant's DentalTown magazine.
- "Top 10 list – old post" is a thread/post in applicant's Dental Town forum that describes that some DentalTown posts in a thread (referred to by ssharpe as a "string" here) were then published in applicant's DentalTown magazine.
- "Dental Town Mag...April Issue" is a thread/post in applicant's Dental Town forum that describes how content posted on DentalTown was published in an issue of DentalTown magazine.

### ***Claim Objections***

3. Claim 16 is objected to because of the following informalities:

- Claim 16, "that the" should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-14, 16-32, 49, 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 32, "substantial portion" of a vertical market is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what in particular would constitute a substantial portion.
- Claim 14, it is unclear what step in particular is performed when applicant claims "advertising is available".
- Claims 23-25, there is no antecedent basis for "thread information".
- Claim 32 is an apparatus claim, yet it is unclear what structure is responsible for "providing" the magazine. Note that an apparatus which prints the magazine is taken to be encompassed by the additionally claimed means for printing, Making it clear that simply printing a magazine is not "providing" a magazine.

- Claim 32 is an apparatus claim but it concludes with a statement that the magazine includes advertising. It is not clear if applicant is attempting to claim the printed magazine itself containing advertising, or has simply omitted the structure responsible for printing the advertising.
- Claims 49, 50, "recognizably similar" is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102, 103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-13, 16-39, 42-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchida (JP 2001357142 A).** Tsuchida teaches a system and

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method for soliciting via a computer network opinions, assertions, etc., for a given theme/topic “for discussion and debate” [abstract]. The posted content is then published in a hard-copy publication [abstract]. While there is no patentable distinction made between a book or a magazine, it would have been obvious to one of ordinary skill at the time of the invention to have published the content of Tsuchida’s submitted postings in the form of a magazine as this is a common publication format that is easy to carry and read. Because the posts are taken to be relevant to the theme and because Tsuchida describes the posts as offering discussion and debate, the collection of submitted content is taken to be representative of a “thread” from an online forum – regardless of whether the posts can be read electronically. Although Tsuchida states that a book is published for those who “enjoy reading books”, it would have been obvious to one of ordinary skill at the time of the invention to have also posted the theme submissions to an electronic forum (in addition to the “books”) so that people who enjoy reading online electronic forums can also enjoy the “debate” and “discussions” by reading them online. Posters to the forum are put on notice (permission) that the content they provide to the online forum may be used in the publication. Any readable format printed in the magazine is taken to be recognizably similar (i.e. readable) to that in the forum. It is well known that publications are subsidized by advertising and it would have been obvious to one of ordinary skill at the time of the invention to have provided advertising that is related to the theme/content of the publication. The particular theme/industry is not a patentable distinction and it would have been obvious to one of ordinary skill at the time of the invention to have

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provided content for publications of any theme, including dentistry and to therefore have offered such a publication to dentists or others interested in the dentistry field. Tsuchida does not appear to mention any costs for posting to the forum and it would have been obvious to one of ordinary skill at the time of the invention to have provided the forum for free in order to attract the most content. Official Notice is also taken that magazines, especially trade journals are provided to customers for free, subsidized by advertising. It is also well known for online forums to require registration and it would have been obvious to one of ordinary skill at the time of the invention to have restricted registration to those users having qualifying knowledge in the subject area so as to avoid spam and other unwanted postings. It would have been obvious to one of ordinary skill at the time of the invention to have selected the most popular forum threads for inclusion in the publication in order to provide a popular publication. Applicant's claimed features regarding forum properties (screen names, avatars, post numbers, etc) that are included in the magazine are taken to be standard information elements captured and presented by most online forum systems - including "Ultimate Bulletin Board" apparently put to use by the applicant and would be obvious to include when printing forum posting content in the magazine for full disclosure and interest. The particular format and shading techniques used in the publication are taken to be mere decorative design choices and are not given substantial patentable weight.

**9. Claims 14, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchida (JP 2001357142 A) in view of Kasai (US20020169688).**



10. Regarding claims 14, 40, while it would have been obvious to one of ordinary skill at the time of the invention to have provided advertising inside the publication of Tsuchida, and to have located the advertising arbitrarily, including on every page, there is no explicit teaching of printing advertising related to the subject matter of a proximal article/content. Kasai however teaches that such a practice is commonplace in the publishing industry and that measures are taken to place on-page ads relevant to the subject matter of adjacent article content, so as to increase the effectiveness of the advertising [¶ 0014]. It would have been obvious to one of ordinary skill at the time of the invention to have located advertising which is related to the publication's content of the user's forum posts, So as to provide effective advertising.

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11. **Claims 1, 2, 5, 16, 19, 26, 29-32 are alternatively rejected under 35 U.S.C. 102(a) as being anticipated by Dental Practice Report (Jan/Feb 2003 issue).**

12. Regarding claims 1, 2, 30-32, Dental Practice Report is taken to be a magazine provided to subscribing Dentists and others having interest in the common subject area of dentistry (i.e. to a substantial portion of a vertical market – the dental market). Dental Practice Report makes it clear that clinical discussions (i.e. threads) among the members of the Internet Dental Forum (online forum - IDF) are compiled and published in the magazine. The “manufacturer sponsored reports” indicated as being located on page 41 which are devoted to Ivoclar Vivadent's “VPS Virtual Impression System” and Dentsply Gendex's “DenOptix Digital Imaging System” are taken to represent printed

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advertising for those products. Further, classified advertising is indicated as being on page 63, and an advertisers index on page 65.

13. Regarding claim 5, the contributors to the threads are taken to inherently represent a subset of the forum.

14. Regarding claim 16, the printed content is in a format using an initial question, followed by interactive responses to the question and previous responses, each followed by the author of the post. This is therefore taken to be a format which assists readers in recognizing that the threads are from the online forum.

15. Regarding claims 19, Dental Practice Report prints the city and state for each poster.

16. Regarding claim 26, the posts are taken to be printed chronologically because there is a question that Ken responds to and the subsequent posters also refer to Ken's response.

17. Regarding claim 29, there are at least 3 posts printed.

**18. Claims 3, 4, 6-13, 17, 18, 20-25, 27, 28, 33-39, 42-50 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Dental Practice Report (Jan/Feb 2003 issue).**

19. Regarding claims 3, 4, 35, 36, it is not clear whether a fee is charged to receive the magazine or to access the Internet Dental Forum (IDF). However, Official Notice is taken that it is well known to offer trade magazines for free (subsidized by advertising) as well as to offer online discussion forums for free (such as USENET's

sci.med.dentistry which dates to approx. 1993). It would have been obvious to one of ordinary skill at the time of the invention to have offered both the magazine and the forum for free so as to attract a wide readership.

20. Regarding claims 6-8, 37, it would have been obvious to one of ordinary skill at the time of the invention to have disclosed to the forum contributors how their content may be used so as to provide a truthful understanding of the forum's practices. Official Notice is taken that giving permission to publish, waiving rights to content are generally accepted practices.

21. Regarding claims 9, 10, Official Notice is taken that certain online forums are "moderated" so as to keep the discussions ontopic, to avoid spam, to avoid abusive arguments, etc. It would have been obvious to one of ordinary skill at the time of the invention to have provided a moderation feature to eliminate posts from spammers, for example. Asking a new registrant to answer a question pertaining to the level of expertise desired for joining the discussions would have been an obvious way to eliminate spammers.

22. Regarding claims 11-13, 33, 34, 38, 39, it would have been obvious to one of ordinary skill at the time of the invention that popular threads (according to any well known metric) would tend to have provided popular printed content in the magazine. It would have been obvious to one of ordinary skill at the time of the invention to have selected the most popular forum threads for inclusion in the publication in order to provide a popular publication.

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23. Regarding claims 17, 18, 20-25, 27, 28, 42-47, Official Notice is taken that applicant's claimed features regarding forum properties (screen names, avatars, post numbers, post time/date, registration date, number of posts, alternate shaded posts, etc) that are included in the magazine are taken to be standard information elements captured and presented by most online forum systems - including the prior art "Ultimate Bulletin Board (UBB)" software apparently chosen to run applicant's DentalTown forum and would be obvious to include when printing forum posting content in the magazine for full disclosure and interest. The particular format and shading techniques used in the publication are taken to be mere decorative design choices and are not given substantial patentable weight.

24. Regarding claim 48, there are at least 3 posts printed.

25. Regarding claims 49, 50, it would have been obvious to one of ordinary skill at the time of the invention to have edited any spelling errors in the original posts so that the magazine can be free of spelling errors.

**26. Claims 14, 40 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Dental Practice Report in view of Kasai (US20020169688).**

27. Regarding claims 14, 40, while it would have been obvious to one of ordinary skill at the time of the invention to have provided as much advertising as desired including on every page, there is no explicit teaching of printing advertising related to the subject matter of a proximal article/content. Kasai however teaches that such a practice is commonplace in the publishing industry and that measures are taken to place on-page

ads relevant to the subject matter of adjacent article content, so as to increase the effectiveness of the advertising [¶ 0014]. It would have been obvious to one of ordinary skill at the time of the invention to have located for example advertising related to a provider of articaine proximal to the content from of the forum's discussions of articaine.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/

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jdc